

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

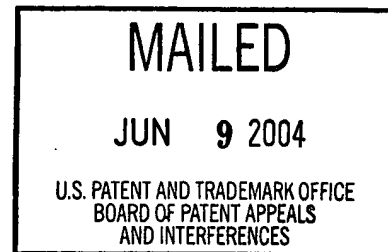
**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALVIN C. ALLEN JR.

Appeal No. 2002-2095
Application 09/206,627

ON BRIEF



Before JERRY SMITH, BARRY and LEVY, Administrative Patent Judges,
JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-11, 14, 16-22 and 24-33, which constitute all the claims remaining in the application. An amendment after final rejection was filed on September 12, 2001 and was entered by the examiner.

The disclosed invention pertains to a method and apparatus for reporting the location of an object. The object receives a page and determines its position using a GPS receiver. The object then reports its position to a monitoring station using a cellular network transmitter. The GPS receiver and the cellular network transmitter are disabled after the location of the object has been transmitted to the monitoring station.

Representative claim 1 is reproduced as follows:

1. A triggerable location-reporting apparatus for use in an environment including: a source of Global Positioning Satellite System (GPS) signals; a source of a trigger signal; a cellular base station connected through a network to a gateway; the cellular base station being configured to expect a Reverse Control Channel signal including a Mobile Identification Number and an Electronic Serial Number, the triggerable location-reporting apparatus comprising:

a GPS receiver responsive to the GPS signals for producing GPS data when enabled;

a cellular network transmitter coupled to the GPS receiver for formatting and transmitting, when enabled, a Reverse Control Channel signal including a formatted GPS data in the place normally occupied by the Electronic Serial Number and a Mobile Identification Number that will cause the cellular base station to send a Registration Notification Invoke signal including the formatted GPS data to the gateway;

a trigger signal receiver responsive to the trigger signal for producing an enable signal;

Appeal No. 2002-2095
Application 09/206,627

an enable controller coupled to the GPS receiver, the cellular network transmitter, and the trigger signal receiver;

the enable controller being configured to enable the GPS receiver and the cellular network transmitter upon receipt of the enable signal from the trigger signal receiver; and

the enable controller being configured to disable the GPS receiver and the cellular network transmitter.

The examiner relies on the following references:

Janky et al. (Janky)	5,777,580	July 07, 1998
Westerlage et al. (Westerlage)	5,826,195	Oct. 20, 1998

Claims 26-33 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Janky. Claims 1-11, 14, 16-22, 24 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Janky and Westerlage.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and

Appeal No. 2002-2095
Application 09/206,627

taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied on by the examiner does not support the examiner's rejections. Accordingly, we reverse. *Spore*

Appellant has indicated that for purposes of this appeal the claims will stand or fall together in the following two groups: Group I has claims 26-33, and Group II has claims 1-11, 14, 16-22, 24 and 25. Consistent with this indication appellant has made no separate arguments with respect to any of the claims within each group. Accordingly, all the claims within each group will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, we will only consider the rejections against claims 1 and 26 as representative of all the claims on appeal.

We consider first the rejection of representative claim 26 as being anticipated by the disclosure of Janky. Anticipation is established only when a single prior art reference discloses,

Appeal No. 2002-2095
Application 09/206,627

expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The examiner has indicated how he finds the invention of claim 26 to be fully met by the disclosure of Janky [answer, pages 3-4]. Appellant's arguments relate to the recitation in claim 26 that the enable controller is configured to disable the location-signal generating device and the telemetry transmitter after the telemetry transmitter transmits the location signal. Appellant notes that the examiner has asserted that this function is inherently performed in Janky, but appellant argues that the examiner has not shown that this function necessarily results from the operation of Janky's device. Appellant argues that the Janky device may perform this function, but does not have to. Appellant also argues that although the Janky device may only contact the contact receiver once, there is no disclosure that

Appeal No. 2002-2095
Application 09/206,627

the transmission of data is disabled after a single transmission. Finally, appellant argues that even if the telemetry transmitter in Janky is disabled after transmitting the location signal, Janky does not teach or suggest that the enable controller does the disabling as claimed [brief, pages 4-6]. The examiner responds that Janky teaches a sleeper mode of operation which conserves power. The examiner asserts that in this mode, the transmitter means of Janky contacts the contact receiver only once and inherently disables the transmitter after the location signal is sent. The examiner also asserts that Janky teaches that the position location information in Janky can be transmitted only once to the contact receiver if desired so as to conserve power in the sleeper mode [answer, pages 10-14]. Appellant responds that there is no teaching in Janky that the contact is terminated after the location information is sent. Appellant argues that if the contact is not terminated, then the transmitter must be enabled. Appellant also repeats the argument that there is no teaching in Janky that the enable controller does the disabling even if it is determined that a disabling takes place in Janky [reply brief, pages 1-4].

Appeal No. 2002-2095
Application 09/206,627

We will not sustain the examiner's rejection of claims 26-33 for essentially the reasons argued by appellant in the briefs. The examiner's rejection is based on the position that the position transmitter in Janky is inherently disabled after the location information has been transmitted in the sleeper mode. The sleeper mode in Janky is described as being in effect before the triggering signal is received. Therefore, the sleeper mode exists before the location page is received. The receiver/processor 31 of Janky is awakened by the triggering signal in the sleeper mode. There is no discussion in Janky, however, as to what happens to the transmitter after the triggering signal is received. In other words, although the powering up operation is described in Janky, there is no indication of whether the transmitting means is subsequently powered down regardless of the number of times that the position location information is transmitted. We agree with appellant that there is no reason why the transmitter means in Janky must be disabled after the location information has been transmitted. Even if the contact and transmission of information in Janky takes place only one time, that would still not necessarily require that the transmission means be disabled after that one

Appeal No. 2002-2095
Application 09/206,627

transmission. It could remain on even if it is not further used.

Since the transmission means of Janky does not have to be disabled after the location information has been transmitted, it cannot be considered an inherent operation of the Janky system as asserted by the examiner. Although we have found that Janky does not anticipate the invention of claim 26, the question of whether it would have been obvious to disable the transmission means of Janky after the location information has been transmitted would seem to be an important question. The question of obviousness on this particular question, however, is not before us, and the factual findings to answer this question have not been developed on this record. We leave it to the examiner to consider whether a record can be presented which supports a rejection of claim 26 under 35 U.S.C. § 103.

We also note that the examiner has failed to address appellant's arguments related to the fact that the examiner has not established a record to support the finding that the enable controller is the element in Janky which performs the disabling as claimed. Therefore, we agree with appellant that on this record, the examiner has failed to demonstrate that the enable controller of Janky is configured to disable the location-signal

Appeal No. 2002-2095
Application 09/206,627

generating device and the telemetry transmitter after the telemetry transmitter transmits the location signal as recited in claim 26.

We now consider the rejection of claims 1-11, 14, 16-22, 24 and 25 under 35 U.S.C. § 103(a) based on the teachings of Janky and Westerlage. Representative independent claim 1 contains the limitations of claim 26 discussed above as well as additional limitations for which Westerlage is used. Appellant's only argument with respect to claim 1 is that the rejection improperly relies on the same erroneous findings with respect to Janky.

We will not sustain the rejection of these claims for the same reasons discussed above. The examiner's reliance on the inherent operation of Janky is erroneous for the reasons discussed above. Although this rejection is under 35 U.S.C. § 103 rather than 35 U.S.C. § 102, there is no record in this case which considers the obviousness of the disabling feature of the claimed invention and the disabling being done by the enable controller as claimed. As noted above, we leave it to the examiner to consider whether a record can be presented which properly supports a rejection under 35 U.S.C. § 103.

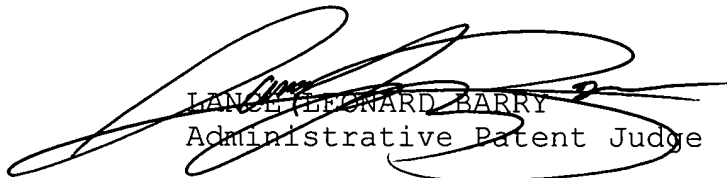
Appeal No. 2002-2095
Application 09/206,627

In summary, we have not sustained either of the rejections of the claims on appeal based on this record. Therefore, the decision of the examiner rejecting claims 1-11, 14, 16-22 and 24-33 is reversed.

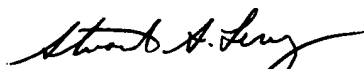
REVERSED



JERRY SMITH
Administrative Patent Judge



LANCELEONARD BARRY
Administrative Patent Judge



STUART S. LEVY
Administrative Patent Judge

)
)
)
)
) BOARD OF PATENT
)
) APPEALS AND
)
) INTERFERENCES
)
)

JS/jlb

Appeal No. 2002-2095
Application 09/206,627

HOWARD L. SPEIGHT
BAKER BOTTS L.L.P.
910 LOUISIANA
HOUSTON, TX 77002